

### **Remarks**

No new matter has been added. Entry of the amendment is respectfully requested.  
Reconsideration is respectfully requested.

### **Claim Status**

Claims 1-29 remain pending in the application. New claims 30-40 have been added to the subject application in this Response. Support for the new claims is provided below. Claims 28 and 29 were present in the Application as filed, but they appear to be unexamined, as the Examiner failed to provide any status for them. It is believed that claims 28 and 29 recite features and relationships not taught or suggested in the applied art and are thus allowable.

Claims 5-16 and 18-25 stand objected to as being dependent upon a rejected base claim. The Examiner has indicated that these claims would be allowable if amended to independent form. The Examiner's early indication of allowable subject matter is greatly appreciated.

Claims 1, 2, 17, and 27 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,567,358 to Takamatsu ("Takamatsu").

Claims 3 and 4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Takamatsu in view of U.S. Patent No. 6,502,746 to Do et al. ("Do").

Claim 26 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Takamatsu in view of U.S. Patent No. 6,493,364 to Shepherd ("Shepherd").

### **The Claim Amendments**

Claim 12 has been amended to correct the inadvertent use of the term “empty envelope holding area.” The proper antecedent term is “deposit envelope holding container” as recited in claim 1. (e.g., Specification p. 36, lines 4-5). No narrowing of claim scope is intended by this amendment.

Claim 13 has been amended to correct the inadvertent use of the term “empty envelope holding container.” The proper antecedent term is “deposit envelope holding container” as recited in claim 1. (e.g., Specification p. 36, lines 4-5). No narrowing of claim scope is intended by this amendment.

Claim 17 has been amended to correct the inadvertent addition of the word “move” in line 3. No narrowing of claim scope is intended by this amendment.

Claim 20 has been amended to correct the inadvertent use of the term “floor surface.” The proper antecedent term is “floor support” as recited in claim 1. (e.g., Specification p. 37, lines 16-18; Figure 11). No narrowing of claim scope is intended by this amendment.

Claim 25 has been amended to correct the inadvertent use of the terms “at least one of the plurality of belts” and “the at least one belt.” The proper antecedent term in the applicable claim stream is “the at least one picker member.” (e.g., Specification p. 46, lines 9-22). No narrowing of claim scope is intended by this amendment.

Claim 27 has been amended to clarify that the empty envelope supporting surface as recited in line 7 is the same supporting surface as referenced in lines 9 and 10. (e.g., Specification p. 36, lines 16-18; p. 37, lines 9-13; p. 37, lines 17-21). No narrowing of claim scope is intended by this amendment.

New claim 30 includes the features and relationships recited in claim 5 as originally filed, which the Examiner has deemed allowable. Claim 7 has been amended to depend from new claim 30. As such, claim 7 is believed to be in condition for allowance.

New claim 31 includes the features and relationships recited in claim 6 as originally filed, which the Examiner has deemed allowable.

New claim 32 includes the features and relationships recited in claim 8 as originally filed, which the Examiner has deemed allowable. Claims 9, 11, 12 and 15 have been amended to depend from new claim 32, and are thus believed to be in condition for allowance.

New claim 33 recites a biasing device operative to bias the stripper member downward. (e.g., Specification p. 38, lines 4-7; Figure 9).

New claim 34 recites the features and relationships of claim 1 as well as a deposit material accepting opening within the housing. Materials deposited into the machine are enabled to be accepted in the deposit opening (where empty envelopes are dispensed) and moved by the at least one transport to the deposit material accepting opening (e.g., Specification p. 39, lines 8-11; p. 48, lines 8-15).

New claim 35 depends from claim 34 and additionally recites a movable gate selectively movable between a blocking position and an open position with respect to the deposit material accepting opening (e.g., Specification p. 40, lines 9-12).

New claim 36 depends from claim 34 and additionally recites at least one cam in operative connection with the floor support, and a plate member movably mounted in supporting connection with the housing. The plate member includes at least one slot, and the cam moves

responsive to engagement with the at least one slot. (e.g., Specification p. 39, line 12-p. 40, line 12; Figs. 9, 10, 17, 18).

New claim 37 depends from claim 1 and additionally recites the at least one picker member comprises a plurality of moving members, wherein each moving member comprises an upper flight of a continuous belt (e.g., Specification p. 37, lines 9-13; Figs. 9-10).

New claim 38 depends from claim 1 and additionally recites a movable support, wherein the floor support is movably mounted in supporting connection with the housing through the movable support (e.g., Specification p. 37, lines 4-8; Fig. 9).

New claim 39 depends from claim 1 and additionally recites a push plate movably mounted in supporting connection with the housing. The push plate is movable between a biasing position and an access position (e.g., Specification p. 36, line 20-p. 37, line 3).

New claim 40 depends from claim 1 and additionally recites a controller and a printhead in operative connection with the controller. The printhead is adapted to print indicia on deposit envelopes being moved by the transport (e.g., Specification p. 35, lines 3-5; p. 70, lines 3-10; Figs. 5 and 51).

### **The Rejections**

#### **35 U.S.C. § 102 Rejections: The Applicable Legal Standards**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would

literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ 2d 1766, 1768 (Fed. Cir. 1987).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Claim 1

The applied art fails to meet the requirements of a proper rejection under 35 USC § 102. Takamatsu discloses an apparatus comprising an ATM with housing 1, input device (keyboard 7) cash dispenser 11, and an envelope issuing unit 150 to hold a stack of empty deposit envelopes. The envelopes are stacked on a press plate 153. An envelope dispensing plate 158 is movable with slidable shafts 156 *disposed at the upper portion of the hopper 151* (Column 8, lines 13-15). After a locking mechanism is disengaged, a customer pulls a handle 8 so that an L-shaped structure at the end of the envelope dispensing plate 158 engages the *uppermost envelope* (see Fig. 9). The L-shaped structure corresponds to approximately the thickness of a single envelope to purportedly prevent additional envelopes from being dispensed.

The Examiner associates Applicants' claimed "at least one movable picker member" with Takamatsu's envelope dispensing plate 158. Claim 1 recites, "at least one movable picker member adjacent the floor support and adapted to engage and move the end envelope." The Examiner's association is inadequate to meet the features and relationships as recited in the claim.

First, Takamatsu fails to provide a movable picker member adjacent the floor support. Second, Takamatsu fails to provide a picker member adapted to engage and move the "end

envelope” which is defined in the claim as “bounding a lower end of the stack.” Third, Takamatsu fails to provide at least one transport that is adapted to move this same “end envelope” to the deposit opening. The Examiner deems the uppermost envelope that is dispensed to a user an “end envelope.” The Examiner also deems the lowermost envelope that is engaged with the press plate 153 an “end envelope.” In the cited reference, the envelope dispensing plate 158 is operative to dispense the *uppermost envelope* in the stack, while the press plate 153 is operative to engage the *lowermost envelope* in the stack. (See Figs. 8 and 9, Col. 8, lines 15-16). However, Applicants’ claim provides a single, discrete object as the claimed “end envelope.” As noted above, anticipation requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell*, 220 U.S.P.Q. at 198. Because the applied reference fails to provide all the features and relationships as recited in the claims, it is requested that the rejection of claim 1 under 35 USC §102 be withdrawn.

Claim 1 is also not obvious in view of the applied reference. Where does Takamatsu teach or suggest a modification of the reference such that the envelope to be dispensed is situated at the bottom of the stack? The envelope issuing unit 150 cannot simply be turned upside down. How would the envelopes be retained in the hopper 151? Only Applicants supply a structure wherein the stack of empty deposit envelopes is supported from the bottom, yet the lowermost envelope is enabled to be singly stripped from the stack, transported to a deposit opening and dispensed. The Examiner may not use Applicants’ own disclosure to supply the necessary modifications to the applied reference.

#### Claim 2

Claim 2 depends from claim 1. Thus, the comments directed to claim 1 above apply equally well to claim 2 and are incorporated herein by reference. Claim 2 recites that the floor support is movably mounted in supporting connection with the housing. The floor support moves vertically relative to the at least one picker member. When the floor support is in a first vertical position, the end envelope is disposed vertically *above* the at least one picker member. When the floor support is in a second vertical position, the end envelope is *engaged with* the at least one picker member. Where does the applied reference teach a first vertical position of the floor support such that the end envelope is disposed *vertically above* the at least one picker member?

The Examiner associates the envelope dispensing plate 158 with the claimed at least one picker member. Further, presumably, the Examiner associates the press plate 153 with the claimed floor support (See Takamatsu Figures 8 and 9, Col. 8). It is admitted that press plate 153 is vertically movable relative to the envelope dispensing plate 158. However, there is no teaching whatsoever that the press plate 153 achieves a vertical position such that the lowermost envelope in the stack (the one adjacent the press plate 153) is disposed vertically above the envelope dispensing plate 158.

Because the applied reference fails to provide all the features and relationships of claim 2, it is requested that the rejection be withdrawn.

#### Claim 17

Claim 17 depends from claim 1. As such, the comments directed to claim 1 above apply equally well to claim 17 and are incorporated herein by reference. Further, claim 17 recites additional features and relationships not shown in the applied art. For example, in claim 17 the

“at least one transport” recited in claim 1 enables movement of the deposit materials into the deposit holding container (See e.g., transport 124; e.g., Specification at page 8, lines 10-12; page 35, lines 10-page 36, line 14; e.g., Figs. 8-16).

The Examiner associates shafts 156 and supports 157 of Takamatsu with Applicants’ claimed “at least one transport.” In accordance with claim 1, the “at least one transport” is adapted to move the end envelope (lowermost envelope) from the stack to a deposit opening that extends through the housing. According to claim 17, the “at least one transport” enables movement of the deposit materials into the deposit holding container. Where does the applied reference teach that shafts 156 and supports 157 enable movement of the deposit materials into the deposit holding container? It does not. Thus, the § 102 rejection is not supported by the applied art. It is respectfully requested that the rejection be withdrawn.

#### Claim 27

Applicants’ claimed “at least one picker member” is characterized as being movable *adjacent* to the empty envelope supporting surface. The Examiner associates Takamatsu’s envelope dispensing plate 158 with Applicants’ picker member and Takamatsu’s press plate 153 with the claimed empty envelope supporting surface. However, dispensing plate 158 is *not* movable adjacent plate 153, as required by the claim. With particular reference to Takamatsu Figure 9, envelope dispensing plate 158 is operable to engage the uppermost envelope in the stack, whereas plate 153 engages the lowermost envelope in the stack. Dispensing plate 158 is thus separated from press plate 153 by the stack of empty envelopes. The Examiner’s assertions fail to provide the claimed features and relationships. It is thus requested that the rejection be withdrawn.



### **35 U.S.C. § 103 Rejections: The Applicable Legal Standards**

The Office has the responsibility to present a *prima facie* case of obviousness under 35 U.S.C. § 103. An Applicant is entitled to a patent if the Office fails to establish a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992). In determining obviousness under 35 U.S.C. § 103, the invention must be considered “as a whole.”

Any modification of the cited reference in order to arrive at Applicant’s invention must be motivated by the cited art. *In re Deminski*, 230 U.S.P.Q. 313 (Fed. Cir. 1986). Applicant’s own disclosure may not serve as a template to piece together the teachings of the prior art to render the claimed invention obvious. *In re Fitch*, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992). There must be a reason or suggestion in the prior art for selecting the claimed procedure, other than knowledge learned from Applicant’s disclosure. *In re Dow Chemical*, 5 U.S.P.Q. 2d 1529 (Fed. Cir. 1988). Further, the motivation for modifying a reference cannot be found if the reference actually “teaches away” from the claimed invention. *In re Gurley*, 31 U.S.P.Q. 2d 130 (Fed. Cir. 1994).

#### **General Comments**

With respect to claims 3 and 4, the Examiner proposes a combination of Takamatsu, wherein an uppermost empty envelope is dispensed, with the teachings of Do, wherein filled previously-deposited envelopes are retrieved from a storage container. In Do, the envelopes are retrieved from the bottom of a stack with a transport mechanism 24.

Applicants’ assert that the proposed combination, and further modification, is legally impermissible. First, there is no teaching or motivation within the references themselves that

would lead one of ordinary skill in the art to modify Takamatsu in the manner proposed by the Examiner. The only modification to the envelope dispenser set forth in Takamatsu is the addition of a spring member to provide an automatic rather than manual return of the handle 8 to the dispensing position (Column 8, lines 24-27). Without motivation in the references themselves the references are not properly combinable.

Second, the proposed combination is impermissible because the proposed combination destroys the teachings of one of the references. Takamatsu teaches that the envelopes are supported on a press plate 153 and that a dispensing plate 158 slides relative to the envelope stack to move only the top envelope. After an envelope is dispensed, the dispensing plate 158 must be repositioned behind the stack of envelopes for a subsequent dispense. In other words, the shafts 156 are moved relative to supports 157 outwardly to dispense the envelope, and then inwardly to reposition the dispensing plate 158. (The Examiner associates shafts 156 and supports 157 with the claimed “at least one transport.”) However, in Do, the transport belts 32 move in only a first direction to position the entire stack 16 of deposited items toward the deposited item retrieval slot 14 (Col. 8, lines 43-45). Two or three envelopes may be retrieved at a time. Envelopes at a height greater than 2 or 3 envelopes are stopped from advancing further by the “somewhat restricted opening 34.” There is no teaching in Do of reversing the direction of travel of the transport belts 32, as such reversal is unnecessary. Because the envelope retrieval process of Do destroys the teachings of Takamatsu, the references may not be properly combined.

Third, Do actually teaches away from the proposed combination. In dispensing the empty envelopes, Takamatsu clearly teaches the need and the means to dispense only a single empty

envelope (Column 8 , lines 15-20; Fig. 9). Takamatsu provides an L-shaped structure to allow the dispense of only a single envelope. However, in Do, it is clearly taught that 2 or 3 previously deposited envelopes may be retrieved at a time. Do clearly is unconcerned with the problem of dispensing only a single empty envelope. With reference to Column 8, lines 51-53, Do teaches that “generally, no more than two or three of the deposited items 16 are transported at once.” One having skill in the art would not be motivated to look to Do when seeking to solve problems such as efficiently dispensing only a single envelope that may be used to make a subsequent deposit.

The Examiner’s statement that a bottom-dispensing design according to Do “may improve in reducing moisture in the storage area so that the envelopes may avoid moisture damage” is totally unsupported by the applied references. Do provides no teaching on this subject.

### Claim 3

Claim 3 depends from claim 2, and ultimately from claim 1. Thus, the comments directed to claims 1 and 2 above are incorporated herein by reference. The deficiencies in the Takamatsu reference with respect to the § 102 rejections are not cured by the combination proposed by the Examiner. Further, even if the combination were proper, which it is not, the proposed combination does not meet the requirements of claim 3.

For example, claim 3 recites that the at least one *picker member* urges a *lower side* of the end envelope to move in the first direction. Claim 3 further recites that the at least one stripper member includes at least one resilient *stripper surface* engaging an *upper side* of the end envelope and resisting movement of the end envelope in the first direction.

The Examiner's proposed combination of Takamatsu with Do fails to provide Applicants' invention when it is considered as a whole. As discussed above, the Examiner associates dispenser plate 158 of Takamatsu with the claimed picker member. Although not clearly taught in the applied reference, for the sake of argument, it is assumed that member 158 engages a *first side* of an envelope to be dispensed. Where is a resilient stripper surface that engages the *opposed side* of an envelope to be dispensed? The Examiner associates the L-shaped structure of Takamatsu with the claimed stripper. Takamatsu does not teach or suggest that the L-shaped structure includes a resilient surface, as claimed. The L-shaped structure does not contact the opposed side of the envelope to be dispensed, as claimed. Do teaches a transport belt 32 and a restricted opening 34. There is no teaching in either of the references of at least one picker member that urges the lower side of an envelope to be dispensed and a stripper member having a resilient stripper surface that engages the upper side of that same envelope.

Further, Applicants' respectfully disagree with the Examiner's assertion that a top-dispensing or bottom-dispensing mechanism is a mere design choice. For one thing, gravitational forces must be considered. For example, in Takamatsu, gravity works to hold the second upper-most envelope against the stack, reducing the need for a precise envelope stripping mechanism. However, in a reversed arrangement, gravity pulls the second-lowermost envelope against the envelope to be dispensed, thus requiring a more precise stripping mechanism to dispense only a single envelope. Because Do is not concerned with the dispense of a single envelope, the necessary stripping mechanism is not provided.

Claim 3 incorporates the features and relationships of claim 2 wherein in a first vertical position, the floor support is disposed vertically above the picker member, and in a second

vertical position, the end envelope (supported on the floor support) is engaged with the picker member. Takamatsu does not teach or suggest such an arrangement. Do does not supply the deficiency. In the suggested combination, how does the Examiner propose to keep Takamatsu's press plate 153 from interfering with the transport? Either the press plate is moved to the top of the dispenser, in which case there is no floor support as claimed, or the press plate interferes with Do's transport at the bottom of the envelope stack. Only Applicants' disclosure provides a solution. It is impermissible to use Applicants' own disclosure as a template to modify the applied references.

It has been shown that the combination of Takamatsu with Do is both legally impermissible and ineffective to render claim 3 as obvious. Thus, it is requested that the rejection of claim 3 be withdrawn.

#### Claim 4

Claim 4 depends from claim 1. As such the arguments above directed to claim 1 with respect to the Takamatsu reference are incorporated herein by reference. Additionally, claim 4 recites many of the features and relationships recited in claim 3. Therefore, the applicable comments directed at claim 3 above are incorporated herein by reference. It is requested that the rejection of claim 4 be withdrawn.

#### Claim 26

The Examiner proposes a combination of Takamatsu with Shepherd in order to render claim 26 as obvious. Shepherd teaches a stepper motor 42 in operative connection with a shutter 34. Takamatsu teaches a shutter mechanism 33 near the card insertion port 13. A replacement of Takamatsu's pulse motor 46 with a stepper motor according to the teachings of Shepherd has

absolutely no bearing on Applicants' claimed invention. Takamatsu provides no teaching whatsoever about a picker mechanism being in operative connection with any motor, pulse, stepper or otherwise. Thus, the proposed combination does not even come close to providing the features and relationships of Applicants' invention.. Additionally, the manual operation of handle 8, which slides the dispenser plate 158, clearly teaches away from a motorized picker mechanism. There are many other arguments as to why the proposed combination is either improper, or ineffective. Applicant reserves the right to raise such arguments if the Examiner insists on retaining this rejection.

#### **New Claims**

Each of the newly added claims recite features and relationships not taught or suggested by the prior art made of record. Thus, it is believed that these claims are in condition for allowance.

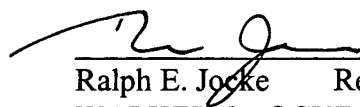
#### **Claim Fees**

Please charge fees for two additional independent claims (in excess of three) at \$200 each, and fees for eleven additional claims at \$50 each for a total of \$950 to Deposit Account No. 09-0428 (Interbold).

### Conclusion

Applicants' have not necessarily present all the reasons as to why the pending claims distinguish from the applied art. Nevertheless, each of Applicants' claims have been shown to be allowable over the cited references. Thus, it is believed that the application is in condition for allowance. The undersigned will be happy to discuss any aspect of the application by telephone at the Office's convenience.

Respectfully submitted,



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